

REMARKS

At the outset, the applicants wish to express their appreciation to the Examiner for withdrawing the rejections based on the prior art and withdrawing the requirement for the recitation relating to "the number of straight-chain alkyl groups".

In the Office Action, the Examiner has rejected claims 1 to 8 under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1 to 9 of U.S. Patent No. 6,410,492. The Examiner maintains that the ester claimed in the referenced patent encompasses the ester claimed in the rejected claims. The applicants traverse the Examiner's contention that the patented ester encompasses the ester claimed herein.

The ester claimed in U.S. Patent No. 6,410,492 is obtained from pentaerythritol and a carboxylic acid mixture comprising a specified amount of m-pentanoic acid, a specified amount of m-heptanoic acid, and a specified amount of 3,5,5-trimethylhexanoic acid. On the other hand, the ester claimed in the instant application is a pentaerythritol ester according to a specified formula which may be obtained as indicated on page 8 of the application. It is respectfully submitted that the refrigerator oil claimed in the instant application is not obvious in view of the refrigerator oil described and claimed in the cited patent.

In addition, the applicants respectfully point out that the application resulting in U.S. Patent No. 6,410,492 has a PCT filing date of September 2, 1999 and a foreign application priority date of September 2, 1998. In the present application, as acknowledged by the

Examiner in the October 16, 2003 Office Action, the application herein and the rejected claims are entitled to a priority date of December 28, 1989 which is well before the earliest effective date of the cited patent. Thus, it is the applicants' contention that the patentability of the claims in the instant application cannot be affected by a patent application or disclosure which did not come into existence until more than nine (9) years later.

In view of the above, it is respectfully submitted that claims 1 to 8 herein are not unpatentable in view of U.S. Patent No. 6,410,492 and the rejection based thereon should be withdrawn. Such action is respectfully solicited.

Respectfully submitted,

HIROSHI HASEGAWA, ET AL

Joseph J. Orlando
Joseph J. Orlando, Reg. No. 25218
Fernanda M. Fiordalisi, Reg. No. 20,938
Allison C. Collard, Reg. No. 22,532

BUCKNAM & ARCHER, P.C.
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802

ENCL. COPY OF PET.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP: FEE AMENDMENT, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on March 16, 2004.

Maria Guastella

MARIA GUASTELLA